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JERRY.SHORMA@HP.COM

mkraft@hp.com

ipa.mail@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY A. SMITH and JOHN F. MAUZEY

Appeal 2007-3103
Application 09/620,617
Technology Center 2600

Decided: August 14, 2008

Before: ROBERT E. NAPPI, JOHN A. JEFFERY and
KEVIN F. TURNER, *Administrative Patent Judges.*

TURNER, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellants' Request for Rehearing (filed March 7, 2008) contends that we erred in our Decision on Appeal, entered January 3, 2008¹, sent to Applicants on January 7, 2008, in which we entered new grounds of rejection of claims 1, 8, 10, and 14. We have reconsidered our decision of January 3, 2008 in light of Appellants' comments in the Request for

¹ The Decision incorrectly lists that the case was decided "January 3, 2007," which is a typographical error.

Rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision for the reasons which follow.

OPINION

In our Decision, we rejected claims 1, 8, 10, and 14 under 35 U.S.C. § 103(a) as unpatentable over Tsunekawa (US 6,734,989), using our authority under 37 C.F.R. § 41.50(b). We respond to the specific points raised by Appellants against the rejections below.

Appellants argue that Tsunekawa does not teach or suggest first and second algorithms generally. (Req. for Reh’g. 3). To the contrary, we find that Tsunekawa details that data received which are not in page description language format are handled differently from data in such a format. (Col. 10, ll. 8-30). This teaches, at least, that different processes are applied dependent on data format and suggests two different algorithms can be applied to the received data. As such, we do not find Appellants’ first point to be compelling.

Appellants also argue that we have provided “no reason the ordinarily skilled artisan would be prompted to modify Tsunekawa in the way claimed,” (Req. for Reh’g. 2), and that improper hindsight, in view of Appellants’ application, would be the only motivation to modify Tsunekawa (Req. for Reh’g. 3). As stated in the New Grounds of Rejection section of the Decision, (p. 11), we found that “[o]ne of ordinary skill in the art could have treated the form data differently, using the same or newly created image data.” Given the teaching of Tsunekawa that different processes can be applied to form data developed from the page description language or transmitted as image data, (Col. 10, ll. 8-30), we find that such different

treatment would be well within common sense for an ordinarily skilled artisan. “Rigid preventative rules that deny recourse to common sense are neither necessary under, nor consistent with, this Court’s case law.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1732 (2007) (citation omitted). As such, we do not find Appellants’ second point to be compelling.

Appellants also argue that Tsunekawa does not teach or suggest “any kind of indicator for printing from new video data or the same video data.” (Req. for Reh’g. 2). However, Tsunekawa details that the printer receives a “form data generating instruction,” Col. 10, ll. 20-25, that details whether form data are developed from the page description language or taken from transmitted image data. We found, and still find, that this instruction is equivalent to the indicator determining whether the printing occurs from new or the same video data. As such, we do not find Appellants’ third point to be compelling.

Appellants also argue that, in Tsunekawa, “once a form is stored, each instance of the form is thereafter printed from the saved data.” (Req. for Reh’g. 2). Also, Appellants argue that “Tsunekawa doesn’t disclose that each instance of a form is ever printed from new data.” (Req. for Reh’g. 3). Tsunekawa makes clear that when form data are registered, later instances are printed using that same stored image data, as recited in claim 1, according to the first printing algorithm. (Col. 10, ll. 8-19). However, if the form data are transmitted as image data, the development of the form data from the page description language is eliminated and data must be printed via “new” data, since it cannot be printed through “old” or “same” data. (Col. 10, ll. 26-30). This second process is performed equivalently to the second algorithm of claim 1. As such, we disagree with Appellants’

argument and do not find it to be compelling. Additionally, Appellants make similar arguments with respect to the rejection of claims 8 and 10, as made for the rejection of claim 1, which we also do not find to be compelling.

Lastly, with respect to claim 14, Appellants argue that Tsunekawa does not disclose “a plurality of commands describing a document” that provide permission regarding printing from new or same video data. However, as discussed above, Tsunekawa clearly details the use of page description language to determine the printing functionality and we find that this page description language is at least equivalent to the claimed plurality of commands. As such, we also fail to find Appellants’ last argument to be compelling.

CONCLUSION

In summary, we have granted Appellants’ Request for Rehearing to the extent that we have reconsidered our decision entering the new grounds of rejection of claims 1, 8, 10, and 14, but we deny the Request with respect to making any changes therein.

DENIED

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HEWLETT PACKARD COMPANY
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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400